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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,337	04/20/2000	Richard R. Reisman	2222.4310003	5134

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
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WASHINGTON, DC 20005

EXAMINER

PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
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2182

MAIL DATE	DELIVERY MODE
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08/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/553,337	REISMAN, RICHARD R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tammara R Peyton	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 114-126, 128-145 and 147-188 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 114-126, 128-145 and 147-188 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicant is advised that the Office vacates the Office Action mailed 07/12/07 due to a mailing error. Applicant's arguments, see Remarks filed 3/19/07, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Qmodem in view of Zellweger, Microsoft, and Pettus.

### ***Information Disclosure Statement***

Regarding the IDS filed 8/9/07, it is desirable to avoid the submission of long list of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

**Claim Objections**

**Claim Rejections - 35 USC § 101**

Independent claims 114 and 153 are rejected under 35 U.S.C. 101 because 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 114 and 153 recite "Software stored on a computer-readable storage medium at a user station, comprising" or "A user station, comprising a processor and software stored on a computer-readable storage medium, the software including" where all of the elements would reasonably be interpreted by one of ordinary skill in light of the disclosure as software, per se. Therein, the claims describe software, per se that is not limited to tangible embodiments. In view of Applicant's disclosure (specification, pgs. 8-11, pg. 38, lines 1-3, pg. 40, lines 1-13, pg. 42, line 2), the claim language of "an online service selector function", a common communications function", "graphical user interface functions" are examples of software, per se. Explanation/Correction is required. Claims 2-13 and 21 are also rejected because of the rejected independent claims.

**Claim Rejections - 35 USC § 112**

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Claims 114, 128-131, 133, 147-150, 153, 166-169, 171, and 184-186, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner has reviewed the specification and cannot find support for the following claim limitations:

"a common communication function" – as recited in claims 114, 133, 153, and 171.

"a plurality of graphical user interface functions" – as recited in claims 114, 130, 131, 133, 153, and 171, the term "graphical" is mention twice in the Specification - pg. 42, line 2 and pg. 59, line 15

"customized graphical user interface functions" – as recited in claims 114, 133, 149, 150, 153, 168, 169, 171, and 186, the term "customized" is paired with "user interface" (pg. 42, lines 26) but no where in the Specification is the term "customized graphical user interface function" paired.

"a different customized database function" – as recited in claims 128, 129, 147, 148, 166, 167, 184, and 185.

Applicant is required to either remove the new matter, or specifically point out in the disclosure the support for the above limitations - in the reply to this Office Action

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 114, 116-131, 133-150, and 152, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Qmodem-Advanced Communications Operation Manual*, Version 4.0, 1989 and Microsoft Press' Computer Dictionary, 2<sup>nd</sup> Edition, 1993 and *Zellweger* (US 5,630,125), cited as prior art 01/17/06.

As per claims 114, 124, 127-131, 133, 146-150, and 152, *Qmodem* teaches software stored on a computer-readable storage medium at a user station configured for communications comprising:

an online service selector function (*Qmodem*), storable and executable at the user station, that enables a user at the user station to select among a plurality of available online service providers (Genie, Forbin Project, Sound of Music, etc. pgs. 108-110 – *Qmodem* Phone Book); and

a common communication function, storable and executable at the user station, that establishes a communication link between the user station and each online service, when the online service is selected.

*Qmodem* is software application for a user's modem. *Qmodem* software is usually pre-installed on the user's computer however executable floppy disks are provided if needed. *Qmodem* is pre-installed with a dialing directory phone book that includes access numbers for a host of online service providers that the user may choose to dial. The user may scroll down the available numbers and when a particular choice is highlighted the user may dial that highlight choice. One number in the dialing directory phone book is Genie. Genie is/was an online service provider by General Electric. *Qmodem* allows the user to select to dial into the Genie online service provider via the access number 277-4741. It is obvious that once the number is dialed and the modem connects to Genie's server, handshaking between the user's modem and the remote modem is done thereby establishing a communication link between the user station and the online provider Genie. Another example of online service providers or Bulletin Board Systems (BBS) would be the Forbin Project, Sound of Music, Hayes Support BBS or the Sail Air PCBoard. (pg. 110) Each of these online service providers has different access numbers that the user may choose to dial. Specifically, the user may choose to dial into a BBS to post messages to other BBS users in special areas devoted to a particular topic. BBS also allows user to chat online with other users, send e-mail, download and upload files, and access the Internet.

*Qmodem* teaches a user interface function for the phone directory, which allows the user to choose between online service providers. The user interface is standard and does not depend upon which one of the online service provider is chosen. Further, *Qmodem* enables the user to submit functional requests to the selected online service provider. (pgs. 139, 152-167, 176-179)

*Qmodem* does not expressly teach a *different customized* graphical user interface function that presents the user with a customized user interface for each different online service provider and functions are downloaded from the selected online. However, as understood by Examiner the generic application function disclosed in Applicant's invention provides open-ending software. After reading Applicant's arguments (03/19/05), Applicant argues that *Qmodem* does not permit the use of a graphical user interface, *Qmodem* (and *QmodemPro*) is/are a terminal emulator wherein it has no provision for downloading customized graphical user interfaces (GUI) from multiple online service providers, and no provision for executing program logic as an element or function of the downloaded GUIs.

However, Examiner does not believe that the lines cited specifically clarify that there are customized interfaces initially stored on the system and it would have been obvious to one of ordinary skill that during handshaking between the user's modem and the remote modem of the selected online service provider is performed using



*Qmodem*'s communication parameters that respective application program data related to the selected online service provider is received at the user's station.

Further, the definition of "individual customized interface" is not defined by the claim in such a way that will not further distinguish the claim invention in terms of patentability, i.e. there is no clear definition of what is meant by customized graphical user interface. Examiner believes once the user selects a publisher's service and dials into the publisher's network that the publishers download to the user station an individual customized interface via connection to the publisher's service. It would have been obvious to one of ordinary skill in the art at the time of invention that the interaction window screen of the selected online service provider would be "individually customized" with the respective application program, i.e. color, frames, layout, font color and font size, etc downloaded to the user station. Examiner does not understand why Applicant believes that of the plurality of online service providers or Bulletin Board Systems (BBS) disclosed by *Qmodem*, the exact same interface (i.e. color, frames, layout, font color and font size) of the plurality of online service providers or BBS would be used to interact with the user. Specifically, *Qmodem* discloses a plurality of online service providers or BBS including Forbin Project, Sound of Music, Hayes Support BBS or the Sail Air PCBoard. (pg. 110) that each have individualize customized interfaces, i.e. (different use of color, frames, layout, font color and/or font size) Further, one of ordinary skill would readily recognize that any changes to the online-service provider's

user interface is stored so that when the user subsequently dials into the server of the online-service providers the same changes would be reloaded.

Examiner is maintaining the position that the user of a graphical user interface with a DOS-based interface would have been an obvious implementation of a well-known interface in the art. Specifically, Microsoft Press defines a graphical user interface as "a type of display format that enables the user to choose commands, start programs, and see list of files and other options....choices can generally be activated either with the keyboard or with a mouse...for application developers, GUIs offer an environment that takes care of the direct interaction with the computer...this frees the developers to concentrate on the application without getting bogged down in the details of screen display or mouse and keyboard input...its also enables programmers to create programs that always handle frequently performed tasks...in the same way because the interface provides standard controlling mechanisms such as windows and dialog boxes." (see pg. 185)

It appears that applicant argued that the motivation to combine Qmodem with Microsoft is not found in a specific reference. Applicant is off the mark in arguing that the motivation to combine needs to be found in a specific reference. (*In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992)) The measure is what the teachings of the references would suggest to one of ordinary skill in the art, not what the references specifically suggest. Further, it must be recognized that any judgment on obviousness is in a

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sense necessarily a reconstruction based upon hindsight reasoning of graphical user interfaces provided by online services. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. (*See In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971))

However, *Zellweger* teaches the use of DOS based applications incorporating the use of GUI. Specifically, *Zellweger* teaches an information management system that implements an open hierarchical data structure, wherein the system is designed to run on DOS in either a text mode or a GUI mode. *Zellweger's* software system incorporates the use of GUI in DOS based applications by simulating a graphical user interface with customized character based menus that is generated by an application module (col. 12, lines 38-col. 14, lines 1-61, cols. 17-26). Examiner is taking the position that the use of a graphical user interface with a DOS-based interface would have been an obvious implementation of a well-known interface in the art.

Therefore, one of ordinary skill in the art would readily recognize that it would have been obvious to implement a GUI as the user interface to *Qmodem's* DOS environment, as taught by *Zellweger*, because the DOS environment is a known field of endeavor that may prompt variations; therein, the design incentives or previous market forces provide a reason to make such a predictable adaptation, such as the

incorporation of a GUI user interface with the *Qmodem* application would furthermore give the user the ability to make interactions with other applications easier.

As per claim 116, it would have been obvious to one of ordinary skill that, handshaking between the user's modem and the remote modem is performed using *Qmodem's* communication parameters (pg. 19) for its communication port to effectuate some data transfer between the user station and the online provider.

As per claims 117 and 136, *Qmodem* teaches an application programming interface (menu) that is user friendly (higher-level – as defined in specification pg. 15, lines 4-12) in which interaction with the user is simplified. (pgs. 139, 152-167, 176-179) Zellweger also teaches a GUI in which interaction with the user is simplified.

As per claims 118-123, 138-143, an object manifest is defined in the specification as conveying the status of a transport operation and to provide for additional information when needed. *Qmodem* teaches an object manifest to effectuate data transfers with communication parameters (pg. 19) for its communication port and its file transport protocols between the user station and the selected online service provider.

As per claims 125, 126, 134, 135, 137, 144, 145, *Qmodem* that wherein the user station is configured for communications with a multiplicity of independently-operated data sources via non-proprietary network (telephone switched-Internet), and further

comprises a data transport function that effectuates data transfers between the user station and a selected one of the independently-operated data sources via the non-proprietary network. One of ordinary skill would readily recognize that the software application *Qmodem* would use the communication parameters (pg. 19) for its communication port to effectuate some data transfer between the user station and the online provider. It is the position of the Examiner that the software application *Qmodem's* pre-installed dialing directory phone book gives the user the option to select between different independently operated data sources via a non-proprietary network.

Claims 115, 132, and 151, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Qmodem-Advanced Communications Operation Manual, Version 4.0, 1989, Zellweger, and Pettus, US 6,031,977* – cited Prior Art, page # 7.

As per claims 115, 132, and 151, *Qmodem* does not expressly a set of translators and protocol drivers for each operated data source already stored on the user station, because, *Qmodem* teaches wherein the user has to download external protocols to facilitate a communication link between the user's modem and some remote modems. (*Qmodem*, pg. 32-34, pg. 153,161)

*Zellweger* teaches a Retrieval module 3 that reside on the hard drive 30 on the user station. The Retrieval module 3 provides a means for transferring product orders from the user station to the suppliers. *Zellweger* also teaches an alternative embodiment wherein the Retrieval module 3 includes configuration and functional

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components that are installed and executed on an end-user computer or executed on a remote computer. (*Zellweger*, Abstract, col.7, lines 43-col. 8, lines 1-34, col. 13, lines 14-col. 16, line 1-15, Fig. 2)

However, *Pettus* discloses a local communication directory service that allows a user to browse and select information that is located on remote libraries. The user station stores a network address and service object (protocol driver) associated with each available service offered on a communication network. If the user desires to acquire access to a remote service listed in the communication directory the appropriate protocol drivers are utilized to facilitate establishment of the communication link. (*Pettus*, col. 4, lines 12-38, Fig. 11, col. 15, lines 19-col. 16, lines 1-40)

It would have been obvious to one of ordinary skill that *Qmodem-Zellweger* would have been motivated to include specific protocol drivers for each operated data source, as disclosed by *Pettus*, thereby elevating the user in the details for downloading specific protocols that will facilitate a communication link between the user's modem and some remote modems.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571)

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272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh, can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

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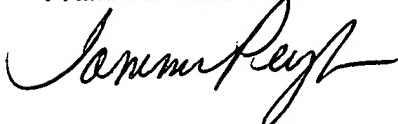
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**TAMMARA PEYTON**  
**PRIMARY EXAMINER**



Tammara Peyton

August 10, 2007